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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,798	10/14/2003	Moshe Olim	S01.12-1003/STL 11508.00	4237

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EXAMINER

WATKO, JULIE ANNE

ART UNIT

PAPER NUMBER

2627

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/684,798

Applicant(s)

OLIM, MOSHE

Examiner

Julie Anne Watko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-6,16,21,23-26 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4-6,16 and 28-30 is/are allowed.
- 6) ☒ Claim(s) 21 and 23 is/are rejected.
- 7) ☒ Claim(s) 24-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/14/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 15, 2006, has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt et al (US Pat. No. 6700746 B1).

It is noted by the Examiner that the reference numerals used in the text of Brandt et al appear inconsistent with the reference numerals in Fig. 3 of Brandt et al. In the explanation below, the Examiner uses the reference numerals from the text of Brandt et al (col. 4, lines 25-65) unless otherwise specified.

As recited in claim 21, Brandt et al show a slider body 18 and an actuation device 22 configured for attachment, the actuation device 22 comprising a mounting surface configured for attachment to the slider, and at least one reservoir ("adhesive zone 34") formed in the actuation device body and extending from the mounting surface ("upper surface ... of the wall 38") towards a surface opposing the mounting surface and configured to receive a portion of adhesive ("adhesive or paste") for attaching the mounting surface to the slider, wherein the at least one

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reservoir has a bottom surface, a first pair of opposing side surfaces and a second pair of opposing side surfaces (see the rectangularly-arranged walls on the left side of the gimbal in Fig. 3).

As recited in claim 21, Brandt et al are silent regarding a reservoir on the slider.

There is no invention in reversal of known parts. In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to locate the claimed surfaces and reservoir on the slider. The rationale is as follows: one of ordinary skill in the art would have been motivated to make an arbitrary expedient design choice as is known in the art.

As recited in claim 23, Brandt et al are silent regarding whether

There is no invention in changing the shape of known parts, when the functioning of the apparatus is not changed by the reshaping. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to arrive at the claimed shape in the course of routine experimentation and optimization. The rationale is as follows: one of ordinary skill in the art would have been motivated to make an arbitrary design choice so as to change a volume of the adhesive zone as is known in the art.

***Allowable Subject Matter***

4. Claims 1, 4-6, 16, and 28-30 are allowed.

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5. Claims 24-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

6. Applicant's arguments filed November 15, 2006, have been fully considered but they are not persuasive.

Applicant's arguments are persuasive with respect to claims 1, 4-6, 16, 24-26 and 28-30.

Applicant's arguments are not persuasive with respect to claims 21 and 23. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "to allow it to couple to more material of a slider and therefore provide a more resilient connection to a gimbal as indicated in the Specification" (see p. 6, 1<sup>st</sup> full paragraph) and "a mounting surface configured to receive an adhesive deposit" (see p. 6, 2<sup>nd</sup> full paragraph)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The features on the gimbal of Brandt et al would meet the limitations recited in claim 21, were the features reversed to the slider. Furthermore, Applicant has failed to show evidence of unexpected results due to the shape recited in claim 23.

Moreover, Applicant's argument that "a partition pattern that adds material to a surface of a component would change the shape of that component. Such a change in shape of a slider causes the slider to perform improperly" is not persuasive. Brandt et al specifically disclose that

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“raised polyimide wall 38 is made by photo-etching processes” (see col. 4, lines 32-34), wherein etching is a notoriously well known process of material removal, not addition.

*Conclusion*

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (571) 272-7597. The examiner can normally be reached on Monday through Friday, 1PM to 10PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Julie Anne Watko, J.D.  
Primary Examiner  
Art Unit 2627

November 21, 2006  
JAW

A handwritten signature in black ink, appearing to read 'Julie Anne Watko', with a long horizontal flourish extending to the right.